

REMARKS

Claims 1-43 are pending in this application. By this Amendment, claims 1, 8, 15-17, 19, 20, 21, 23, 32 and 33 are amended and claims 39-43 are added. Reconsideration based on the following remarks is respectfully requested.

I. Specification

The Office Action asserts that the title of the invention is not descriptive. Applicant respectfully submits that the amended title obviates the objection to the title.

II. Drawings

The Office Action objects to Figs. 6, 10 and 11. Specifically, the Office Action states that Figs. 10 and 11 should be designated prior art. Applicant respectfully submits that Figs. 10 and 11 have been corrected to add the legend "Prior Art".

Regarding Fig. 6, Applicant respectfully submits that corrected drawing for Fig. 6 obviates this objection regarding S8, and swaps the "YES" and "NO" designations.

III. The Claims Define Allowable Subject Matter

A. Claim Rejections Under 35 U.S.C. §103

The Office Action rejects claims 1, 8 and 28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,781,310 to Nakamura in view of U.S. Patent No. 5,469,533 to Dennis. Applicant respectfully traverses this rejection.

The Office Action, in paragraph 9, asserts that Nakamura further discloses that the peripheral device contains a first transmission device that transmits printed data to the host; in Nakamura's system, a controlling and communicating unit 10 (Fig. 1) sends image data to the transmission path 4, to which the image outputting unit 2 and the controlling unit 3 are also connected (Fig. 2 and col. 5, lines 1-4).

Applicant respectfully submits that the cited combination of Nakamura and Dennis fails to disclose or suggest all of the features recited in claims 1, 8 and 28. Specifically, Nakamura fails to disclose or suggest the feature of a first transmission device that transmits to the host device and printable data converted by the converting device. Nakamura discloses that the transmission device (controlling and communicating unit 10) sends image data to the transmission path to which the controlling unit (host) an image outputting unit 2 are also connected. Applicant respectfully submits that although the host is connected to the transmission path, Nakamura does not disclose nor suggest the transmission device that transmits to the host device the printable data converted by the converting device, as recited in claim 1;

a first transmission device that transmits the data converted by the converting device to the host device from the peripheral device, as recited in claim 8; or

a transmission device that transmits to the peripheral device the printable data stored in the storage device by the reception control device as recited in claim 28. The Office Action appears to surmise that since the host device is connected to the transmission path, that the image data must reach the host device; however, Nakamura does not disclose that the transmission device sends the image data to the host device.

Furthermore, Applicant respectfully submits that Dennis does not make up for this deficiency.

The reception printing device of the present application receives the printable data converted by the converting device and transmitted from the host device and causes the printing device to print the printable data.

In contrast, Nakamura discloses that the image outputting unit 2 receives image data directly from the image inputting device and the data is then used to form a full color image. This teaches away from sending data from unit 10 to the host device. Further, the Office Action admits that the printable data is not received from the host device in Nakamura's system.

In addition, Applicant respectfully submits that there is no motivation to combine Nakamura and Dennis. Specifically, there is no motivation to combine Nakamura (a copying system) with Dennis (a resource management printing system). This is further evidenced by the types of data conversion performed in both systems. In Nakamura's system, data is converted into an 8-bit digital system that can be sent to an output device. However, data is converted in Dennis into printable bitmap data which originates from the host computer, and does not originate from an external device.

Thus, the Examiner's reasons for combining Nakamura and Dennis is the result of impermissible hindsight reasoning based on the Applicant's disclosure and therefore, cannot form the basis of a claim rejection under 35 U.S.C. §103.

Withdrawal of the rejection of claims 1, 8 and 28 under 35 U.S.C. §103 is respectfully requested.

B. Claim Rejections Under 35 U.S.C. §102

The Office Action rejects claims 24 and 25 under 35 U.S.C. §102(b) as being anticipated by Nakamura. Applicant respectfully traverses this rejection.

The Office Action, in paragraph 26, asserts that Nakamura further discloses that "the peripheral device contains a first transmission device that transmits printed data to the host; in Nakamura's system, the controlling and communicating unit 10 (Fig. 1) as demonstrated to the transmission path 4, to which the image outputting unit 2 and the controlling unit 3 are also connected (Fig. 2 and col. 5, lines 1-4)."

Applicant respectfully submits that Nakamura fails to disclose or teach all of the features recited in claim 24. Specifically, Nakamura fails to disclose or teach the feature of a transmission device that transmits to the host device the printable data that was converted by the converting device, as recited in claim 24. Nakamura merely discloses a system where the controlling and communicating unit 10 sends image data to the transmission path to which the controlling unit (host) is also connected. Applicant respectfully asserts that Nakamura does not even mention sending the converted image data to the host, as recited in claim 24. The Office Action appears to surmise that since the host device is connected to the transmission path, that the image data must reach the host device; however, Nakamura does not disclose that the transmission device sends the image data to the host device.

Applicant respectfully submits that since claim 25 depends from claim 24, that claim 25 is allowable at least for the reasons stated regarding claim 24.

Withdrawal of the rejection of claims 24 and 25 under 35 U.S.C. §102(b) is respectfully requested.

C. Claim Rejections Under 35 U.S.C. §103

The Office Action rejects claims 2, 9 and 29 under 35 U.S.C. §103(a) as being unpatentable over Nakamura, in view of Dennis. Applicant respectfully traverses this rejection.

Applicant respectfully submits that since claims 2, 9 and 29 depend from claims 1, 8 and 28 respectively, that claims 2, 9 and 29 are allowable at least for the reasons stated regarding claims 1, 8 and 28.

Withdrawal of the rejection of claims 2, 9 and 29 under 35 U.S.C. §103(a) is respectfully requested.

D. Claim Rejections Under 35 U.S.C. §103

The Office Action rejects claims 3, 10 and 30 under 35 U.S.C. §103(a) as being unpatentable over Nakamura in view of Dennis, in further view of U.S. Patent No. 5,717,843 to Tabata. Applicant respectfully traverses this rejection.

Applicant respectfully submits that since claims 3, 10 and 30 depend from claims 1, 8 and 28, respectively, that claims 3, 10 and 30 are allowable at least for the reasons stated regarding claims 1, 8 and 28.

Withdrawal of the rejections of claims 3, 10 and 30 under 35 U.S.C. §103(a) is respectfully requested.

E. Claim Rejections Under 35 U.S.C. §103

The Office Action rejects claims 4, 11, 18, 31 and 35 under 35 U.S.C. §103(a) as being unpatentable over Nakamura in view of Dennis, in further view of Tabata. Applicant respectfully traverses this rejection.

Applicant respectfully submits that since claims 4, 11 and 31 depend from claims 1, 8 and 28, respectively, that claims 4, 11 and 31 are allowable at least for the reasons stated regarding claims 1, 8 and 28, respectively.

Regarding claims 18 and 35, Applicant respectfully submits that since claims 18 and 35 depend from claims 15 and 32 respectively, that claims 18 and 35 are allowable at least for the reasons stated regarding claims 15 and 32, *infra*.

Withdrawal of the rejection of claims 4, 11, 18, 31 and 35 is respectfully requested.

F. Claim Rejections Under 35 U.S.C. §103

The Office Action rejects claims 5, 12, 19 and 36 under 35 U.S.C. §103(a) as being unpatentable over Nakamura, in view of Dennis.

Applicant respectfully submits that since claims 5 and 12 depend from claims 1 and 8, respectively, that claims 5 and 12 are allowable at least for the reasons stated regarding claims 1 and 8.

Regarding claims 19 and 36, Applicant respectfully submits that since claims 19 and 36 depend from claims 15 and 32 respectively, that claims 19 and 36 are allowable at least for the reasons stated regarding claims 15 and 32, *infra*.

Withdrawal of the rejection of claims 5, 12, 19 and 36 under 35 U.S.C. §103(a) is respectfully requested.

G. Claim Rejections Under 35 U.S.C. §103

The Office Action rejects claims 6, 13, 22, 26 and 37 under 35 U.S.C. §103(a) as being unpatentable over Nakamura in view of Dennis, in further view of U.S. Patent No. 5,717,507 to Vondran. Applicant respectfully traverses this rejection.

Regarding claims 6, 13 and 26, Applicant respectfully submits that since claims 6, 13 and 26 depend from claims 1, 8 and 24, respectively, that claims 6, 13 and 26 are allowable at least for the reasons stated regarding claims 1, 8 and 24.

Regarding claims 22 and 37, Applicant respectfully submits that since claims 22 and 37 depend from claims 15 and 32, respectively, that claims 22 and 37 are allowable at least for the reasons stated regarding claims 15 and 32, *infra*.

Withdrawal of the rejection of claims 6, 13, 22, 26 and 37 under 35 U.S.C. §103(a) is respectfully requested.

H. Claim Rejections Under 35 U.S.C. §103(a)

The Office Action rejects claims 7, 14, 23, 27 and 38 under 35 U.S.C. §103(a) as being unpatentable over Nakamura in view of Dennis, in further view of U.S. Patent No. 5,381,246 to Suzuki. Applicant respectfully traverses this rejection.

Regarding claims 7, 14 and 27, Applicant respectfully submits that since claims 7, 14 and 27 depend from claims 1, 8 and 24, respectively, that claims 7, 14 and 27 are allowable at least for the reasons stated regarding claims 1, 8 and 24.

Regarding claims 23 and 38, Applicant respectfully submits that since claims 23 and 38 depend from claims 15 and 32, respectively, that claims 23 and 38 are allowable at least for the reasons stated regarding claims 15 and 32, *infra*.

Withdrawal of the rejection of claims 7, 14, 23, 27 and 38 under 35 U.S.C. §103(a) is respectfully requested.

I. Claim Rejections Under 35 U.S.C. §103(a)

The Office Action rejects claim 15 under 35 U.S.C. §103(a) as being unpatentable over Nakamura, in view of Dennis. Applicant respectfully traverses this rejection.

The Office Action asserts that method steps of claim 15 are all performed by the means of Nakamura and Dennis' apparatuses as described above in claim 1.

Applicant respectfully submits that cited combination of Nakamura and Dennis fails to disclose or suggest all of the features recited in claim 15. Specifically, Nakamura and Dennis fails to disclose or suggest the feature of the transmitting step of claim 15 which recites "transmitting to the host device the converted printable data". As stated above regarding claim 1, Nakamura fails to disclose or teach transmitting the printable data to the host, device as recited in claim 15. Nakamura merely discloses transmitting data to a bus to which the host device is merely connected. Nakamura does not mention transmitting data to the host. The Office Action appears to surmise that since the host device is connected to the

transmission path, that the image data must reach the host device; however, Nakamura does not disclose that the transmission device sends the image data to the host device. Dennis does not make up for this deficiency.

Withdrawal of the rejection of claim 15 under 35 U.S.C. §103(a) is respectfully requested.

J. Claim Rejections Under 35 U.S.C. §103(a)

The Office Action rejects claims 16, 20 and 33 under 35 U.S.C. §103(a) as being unpatentable over Nakamura, in view of Dennis. Applicant respectfully traverses this rejection.

Regarding claims 16 and 20, Applicant respectfully submits that since claims 16 and 20 depend from claim 15, that claims 16 and 20 are allowable at least for the reasons stated regarding claim 15.

Regarding claim 33, Applicant respectfully submits that since claim 33 depends from claim 32, that claim 33 is allowable at least for the reasons stated regarding claim 32, *infra*.

Withdrawal of the rejection of claims 16, 20 and 33 is respectfully requested.

K. Claim Rejections Under 35 U.S.C. §103

The Office Action rejects claims 17, 21 and 34 under 35 U.S.C. §103(a) as being unpatentable over Nakamura in view Dennis, in further view of Tabata. Applicant respectfully traverses this rejection.

Regarding claims 17 and 21, Applicant respectfully submits that since claims 17 and 21 depend from claim 15, that claims 17 and 21 are allowable at least for the reasons stated regarding claim 15.

Regarding claim 34, Applicant respectfully submits that since claim 34 depends from claim 32, that claim 34 is allowable at least for the reasons stated regarding claim 32, *infra*.

Withdrawal of the rejection of claims 17, 21 and 34 under 35 U.S.C. §103(a) is respectfully requested.

L. Claim Rejections Under 35 U.S.C. §103

The Office Action rejects claim 32 under 35 U.S.C. §103(a) as being unpatentable over Nakamura, in view of Dennis. Applicant respectfully traverses this rejection.

The Office Action asserts that the copy program implements the method of claim 15, and that all the steps implemented by the copy program are performed in the method of claim 15.

Applicant respectfully submits that the cited combination of Nakamura and Dennis fails to disclose or suggest all of the features recited in claim 32. Specifically, Nakamura and Dennis fails to disclose or suggest the feature "a first transmission step that transmits to the host device the printable data converted in the converting step" as recited in claim 32. As discussed above regarding claim 15, Nakamura merely discloses transmitting converted data to a bus, and not to the host device, as recited in claim 32. Dennis does not make up for this deficiency.

Withdrawal of the rejection of claim 32 is respectfully requested.

IV. Conclusion

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-43 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

David E. Brown
Registration No. 51,091

JAO:DEB/rle

Attachments:

Replacement Sheets (Figs. 6, 10 and 11)
Amendment Transmittal
Petition for Extension of Time

Date: June 15, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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